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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/954,874	09/12/2001	Irwin Jerold Singer	17037A	8268

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EXAMINER

SALVATORE, LYNDIA

ART UNIT	PAPER NUMBER
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1771

DATE MAILED: 06/05/2003

4

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/954,874

Applicant(s)

SINGER ET AL.

Examiner

Lynda M Salvatore

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 23 September 2002.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 16-45 is/are pending in the application.
- 4a) Of the above claim(s) 1-15 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 16-45 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) ✓
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2,3.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

**DETAILED ACTION**

***Election/Restrictions***

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 1-15, 46, and 47 drawn to a sensitive surface protective material classified in class 442, subclass various 327
  - II. Claims 16-45, drawn to a storage sleeve classified in class, 150 subclass 154+.

2. The inventions are distinct, each from the other because:

Inventions of Group I and Group II are related as mutually exclusive species in an intermediate-final product relationship. Distinctness is proven for claims in this relationship if the intermediate product is useful to make other than the final product (MPEP § 806.04(b), 3rd paragraph), and the species are patentably distinct (MPEP § 806.04(h)). In the instant case, the intermediate product is deemed to be useful as non-woven fabric and the inventions are deemed patentably distinct since there is nothing on this record to show them to be obvious variants. Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions anticipated by the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

3. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

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4. During a telephone conversation with Ralph Dean on March 14<sup>th</sup>, 2003 a provisional election was made with traverse to prosecute the invention of Group II directed to a storage sleeve claims 16-45. Affirmation of this election must be made by applicant in replying to this Office action. Claims 1-15, 46, and 47 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

5. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

6. Applicant is advised that the reply to this requirement to complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

#### ***Claim Objections***

7. Claim 16 is objected to because of the following informalities: Claim 16 depends from a non-elected claim. Appropriate correction is required.

#### ***Claim Rejections - 35 USC § 112***

8. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

9. Claim 17 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Specifically, claim 17 is indefinite for reciting the physical properties of the non-

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woven web (i.e., bulk density and Gurley stiffness). *Ex parte Slob*, 157 USPQ 172, states the following with regard to an article claimed by defining property values:

Claims merely setting forth physical characteristics desired in article, and not setting forth specific compositions which would meet such characteristics, are invalid as vague, indefinite, and functional since they cover any conceivable combination of ingredients either presently existing or which might be discovered in future and which would impart desired characteristics, thus, expression "a liquefiable substance having a liquefaction temperature from 40°C. to about 300°C. and being compatible with the ingredients in the powdered detergent composition" is too broad and indefinite since it purports to cover everything which will perform the desired functions regardless of its composition, and in effect, recites compositions by what it is desired that they do rather than what they are; expression also is too broad since it appears to read upon materials that could not possibly be used to accomplish purposes intended.

Thus, claim 17 is indefinite for reciting only the desired physical properties of the non-woven rather than setting forth structural and/or chemical characteristics of said non-woven. Claims 18-45 are further rejected for their dependency on claim 17.

### ***Claim Rejections - 35 USC § 102/103***

10. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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11. Claims 16-20 are rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over McDevitt et al., US 2003/0050589.

The patent issued to McDevitt et al., teaches a disposable finger sleeve having a pocket for the insertion of a finger (Title and Section 0025). The finger sleeve is preferably formed out of a non-woven web base material made from pulp, synthetic, meltblown, spunbonded carded bicomponent, and/or crimped fibers (Section 0025). McDevitt et al., teaches forming the finger sleeve having one open end and one closed end from two or more sections of non-woven web base material wherein each section can be identical or different as a function of desired end use (Section 0044 and 0048). McDevitt et al., also teaches that in some embodiments the finger sleeve can further include a moisture barrier, layer, or film that is incorporated into the non-woven web base material (Section 0027). Suitable breathable or apertured film materials include polyethylene or polypropylene and can be incorporated or attached to the non-woven web base material to form a laminate structure (Sections 0104, 0105, and 0106). McDevitt et al., teaches adhesive, thermal or mechanical bonding techniques to join the sections of non-woven web base material to form the finger sleeve (Section 0049).

Although, McDevitt et al., does specifically teach the claimed Gurley stiffness property as set forth in claims 17 and 18, it is reasonable to presume that said property is inherent to the invention of McDevitt et al. Support for said presumption is found in the use of like materials (i.e., non-woven web of bicomponent filaments and polyethylene or propylene film), which would result in the claimed property. The burden is upon the Applicant to prove otherwise. *In re Fitzgerald* 205 USPQ 594

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In addition, the presently claimed property of Gurley stiffness would have obviously been present once the McDevitt et al., product is provided. *In re Best*, 195 USPQ 433, footnote 4 (CCPA 1977)

With regard to the bulk density limitation recited in claims 17 and 18, McDevitt et al., does not disclose the bulk density, however it would have been obvious to one having ordinary skill in the art at the time the invention was made to optimize the value of the bulk density as a function of intended final use. It has been held that discovering an optimum or workable ranges involves only routine skill in the art. *In re Aller*, 105 USPQ 233

***Claim Rejections - 35 USC § 103***

12. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

13. Claims 16-45 are rejected under 35 U.S.C. 103(a) as being unpatentable over Drew, US 6,186,320 in view of McDevitt et al., US 2003/0050589.

The patent issued to Drew teaches a double sided storage sleeve comprising flexible first, third, and a flexible non-woven, non-laminated second sheet positioned between said first and third sheet (Claim 1). The flexible first, third, and second sheet are interconnected together on the bottom edge and two side edges to form two pockets (Claim 1). The flexible non-woven second sheet comprises a spunbonded, continuous polypropylene fiber (Claim 1). The flexible first and third sheets may be comprised of a transparent material such as plastic, vinyl or propylene, or non-woven materials (Column 3, 55-65).

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Drew does not specifically teach the limitations set forth in claims, 24-38, however, the patent issued to McDevitt et al., teaches examples of bicomponent fibers such as those having two materials arranged in a sheath/core or side-by-side relationship (Section 0065). Typical materials used to make bicomponent fibers include a core of nylon or polyester and a sheath of polyethylene or polypropylene or polypropylene/polyethylene bicomponent fibers (Section 0065 and 0113). McDevitt et al., teaches that such synthetic fibers add strength, bulk, softness, and smoothness to the non-woven. Therefore, with regard to claims 24-28 and 30-38, it would have been obvious to one having ordinary skill in the art to use bicomponent fibers such as the ones taught by McDevitt et al., in the storage sleeve of Drew. Motivation for this argument is found in the explicit, teachings of McDevitt et al.

Drew does not specifically teach the through-air-bonding limitation set forth in claims 24,34, however, McDevitt et al., teaches various bonding methods such as through-air-bonding, oven and ultrasonic bonding to increase the strength non-woven webs comprising substantial amounts of synthetic fibers (Section 0071). Therefore, motivated to increase the strength of the non-woven web it would have been obvious to one having ordinary skill in the art to through-air-bond either the first and/or third flexible sheet materials of Drew as taught by McDevitt et al.

Drew does not teach point bonding to provide a non-woven web with a pattern, however, McDevitt et al., teaches thermal point bonding in the range of 50% total bond area or less (Section 0072). McDevitt et al., teaches that the percent bond area is affected by the type(s) of polymeric materials used in forming the fibers of the non-woven web base material and if the non-woven web base material is single or multi-layered (Section 0073). Therefore, motivated to bond the fibers together so as to form a pattern it would have been obvious to one having



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ordinary skill in the art at the time the invention was made to employ the thermal point bonding method taught by McDevitt et al. in the invention of Drew.

Although, McDevitt et al., and Drew do not specifically teach the claimed Gurley stiffness property as set forth in claims 17 and 18, it is reasonable to presume that said property is inherent to the invention of McDevitt et al. and Drew. Support for said presumption is found in the use of like materials (i.e., non-woven web of bicomponent filaments and polyethylene or propylene film), which would result in the claimed property. The burden is upon the Applicant to prove otherwise. *In re Fitzgerald* 205 USPQ 594

In addition, the presently claimed property of Gurley stiffness would have obviously been present once the McDevitt et al. and Drew product is provided. *In re Best*, 195 USPQ 433, footnote 4 (CCPA 1977)

With regard to the bulk density limitation recited in claims 17 and 18, McDevitt et al., does not disclose the bulk density, however it would have been obvious to one having ordinary skill in the art at the time the invention was made to optimize the value of the bulk density as a function of intended final use. It has been held that discovering an optimum value of a result effective variable involves only routine skill in the art. *In re Boesch*, 617 F.2d, 272,205 USPQ 215 (CCPA 1980)

### ***Conclusion***

14. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

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US 3,763,907

US 2002/0189147 A1

US 2002/0178482 A1

15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lynda M Salvatore whose telephone number is 703-305-4070.

The examiner can normally be reached on M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel Morris can be reached on 703-308-2414. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9310 for regular communications and 703-872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.

ls  
May 30, 2003

  
TERREL MORRIS  
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TECHNOLOGY CENTER 1700